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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,693	07/08/2003	Hiroto Ohkawara	1232-5079	9702
27123	7590	09/30/2004	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			RAIZEN, DEBORAH A	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/615,693	OHKAWARA, HIROTO	
	Examiner	Art Unit	
	Deborah A. Raizen	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0604</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

On page 9, line 11, “amplifier 109” should be changed to “amplifier 110” to agree with Figure 1.

On page 12, line 3, “the focusing/compensating lens 104” should be changed to “the focusing/compensating lens 105” to agree the figures and with the rest of the specification.

On page 12, line 24, “unit 609” should be changed to “unit 607” to agree with Fig. 8B and with line 20.

On page 15, line 1, it appears that “increasing” should be changed to “decreasing” to agree with Fig. 4.

On page 15, line 3, it appears that “decreasing” should be changed to “increasing” to agree with Fig. 4.

Appropriate correction is required.

### *Claim Objections*

2. Claims 1, 3-6, and 8-11 are objected to because of the following informalities: it is not grammatically correct to recite modes and states without reciting which subject is in those modes or states. For example, in the last line of claim 1, “when in the automatic focusing mode” suggests that either the power supply control device or the detecting device is in the automatic focusing mode, neither of which is correct.

In claim 1, the quoted phrase should be replaced with “when the apparatus is in the automatic focusing mode”.

In claim 3, the problem can be corrected as follows: “... wherein said power supply control device permits power supply to said detecting device when the apparatus is in a focusing-locked state ~~when~~ in the automatic focusing mode.”

Similar changes can correct the grammatical problem in the other claims (claims 5 and 10 inherit the objection because they depend on claims that have the problem).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-6, and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation in dependent claims 3 and 8 “permits power supply to said detecting device in a focusing-locked state when in the automatic focusing mode” makes the meaning of the limitation in the base claims 1 and 6 “prohibits power supply to said detecting device when in the automatic focusing mode” unclear. The meaning is also unclear in claim 11, in light of the above contradiction in limitations and in light of the disclosure. In claims 4 and 9, the meaning of the limitation “prohibits power supply to said detecting device when in the viewing mode” is

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also unclear in light of the above contradiction in limitations. Claims 5 and 10 inherit the rejection.

The following clause should be added at the end of claims 1, 6, and 11 to correct the contradiction:

“unless the apparatus is in a focusing-locked state”

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Suh (5,606,382).

In regard to claim 1, as understood, Suh discloses an image pickup apparatus (a camera, col. 2, line 15; Fig. 3) comprising:

a detecting device (4 and 6 in Figs. 3 and 6) adapted to detect the quantity of variation resulting from the rotation of a ring member (8 in Figs. 3 and 6, col. 3, lines 50-60);

a lens shifting control device adapted to shift/stop image pickup lenses in the direction of their optical axis on the basis of the result of detection by said detecting device (inherently disclosed because of the disclosure that the stabilized signal, which is the result of detection by said detecting device after passing through stabilizer 23, is used for manual focusing with an inner focus lens, col. 4, lines 22-26); and

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a power supply control device (transistor 2T) adapted to change the state of power supply to said detecting device according to the mode of use (col. 2, lines 35-37 and col. 3, lines 18-20);

wherein said power supply control device prohibits power supply to said detecting device when in the automatic focusing mode (col. 2, lines 31-37).

In regard to claim 5, in the Suh image pickup apparatus, the ring member is provided concentrically with the optical axis of said lenses (inherently disclosed because of the disclosure in Suh that the mechanical structure is the same as the conventional manual focusing with a manual focusing ring, col. 1 and Fig. 1).

In regard to claim 6, as understood, Suh discloses a power supply control method for an image pickup apparatus (a camera, col. 2, line 15; Fig. 3) having a detecting device (4 and 6 in Figs. 3 and 6) adapted to detect the quantity of variation resulting from the rotation of a ring member (8 in Figs. 3 and 6, col. 3, lines 50-60), and a lens shifting control device adapted to shift/stop image pickup lenses in the direction of their optical axis on the basis of the result of detection by said detecting device (inherently disclosed because of the disclosure that the stabilized signal, which is the result of detection by said detecting device after passing through stabilizer 23, is used for manual focusing with an inner focus lens, col. 4, lines 22-26),

the method having a control step of changing the state of power supply to said detecting device according to the mode of use (col. 2, lines 35-37),

wherein said control step prohibits power supply to said detecting device when in the automatic focusing mode (col. 2, lines 31-37).

In regard to claim 10, in the Suh power supply control method, the ring member of said image pickup apparatus is provided concentrically with the optical axis of said lenses (inherently disclosed because of the disclosure in Suh that the mechanical structure is the same as the conventional manual focusing with a manual focusing ring, col. 1 and Fig. 1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suh in view of Watanabe et al. (4,984,000).

Suh discloses method for controlling power supply to an image pickup apparatus (a camera, col. 2, line 15; Fig. 3) having a detecting device (4 and 6 in Figs. 3 and 6) adapted to detect the quantity of variation resulting from the rotation of a ring member (8 in Figs. 3 and 6, col. 3, lines 50-60), and a lens shifting control device adapted to shift/stop image pickup lenses in the direction of their optical axis on the basis of the result of detection by said detecting device (inherently disclosed because of the disclosure that the stabilized signal, which is the result of detection by said detecting device after passing through stabilizer 23, is used for manual focusing with an inner focus lens, col. 4, lines 22-26), wherein the method has a control step of changing the state of power supply to said detecting device according to the mode of use (col. 2, lines 35-

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37), wherein said control step prohibits power supply to said detecting device when in the automatic focusing mode (col. 2, lines 31-37).

However, Suh does not disclose a recording medium having stored thereon a control program for executing the method above.

Watanabe discloses a recording medium (ROM, col. 6, lines 39-42) having stored thereon a control program for executing a power focusing method (Fig. 3, 4A, and 5) that is similar to that of Suh and meets the limitations of the above method except for the limitations regarding power supply to the detecting device. Furthermore, the Watanabe recording medium with the programmed method stored on it allows automation of the power zooming and focusing method for prompt focusing and zooming without putting a photographer to great inconvenience (col. 2, lines 5-9). Furthermore, such a recording medium with a program for executing the method provides flexibility, allowing modifications and additions of steps with code changes rather than with changes in circuitry, as demonstrated by the disclosure in Watanabe.

Therefore, it would have been obvious to one of ordinary skill in the art to provide a recording medium on which are recorded the codes of the Suh method, including control of the power supply to the detecting device, because such a recording medium would allow the Suh method to be carried out automatically to provide prompt focusing without putting a photographer to great inconvenience, and, furthermore, because such a recording medium with a program for executing the method of Suh would provide flexibility to the Suh method, allowing modifications and additions of steps with code changes rather than with changes in circuitry.



***Allowable Subject Matter***

9. Claims 3, 4, 8, and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of claims 3, 4, 8, and 9, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper.

The prior art fails to teach a combination of all the features in claims 3 or 8, as understood. For example, these features include the respective detailed structure (including functional limitations) or steps recited in respective base claims 1 or 6 and also the limitation that the power supply control device or the control step permits power supply to the detecting device in a focusing-locked state when in the automatic focusing mode, in combination with all the other limitations of the claim.

The prior art fails to teach a combination of all the features in claims 4 or 9, as understood. For example, these features include the respective detailed structure (including functional limitations) or steps recited in respective base claims 1 or 6 and also the limitation that the power supply control device or the control step prohibits power supply to the detecting device when in the viewing mode, in combination with all the other limitations of the claim. Although Suh discloses that power supply is permitted only in manual focusing mode, Suh does not anticipate the claim because Suh does not disclose a viewing mode.

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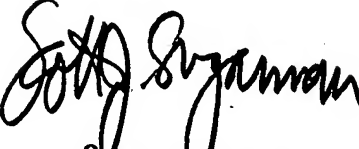
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen, Ph.D., J.D., whose telephone number is (571) 272-2336. The examiner can normally be reached on Monday-Friday, from 10:00 a.m. to 3:00 p.m. Eastern Standard Time (a part-time schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The USPTO central official fax number is (703) 872-9306 (please note that this number is different from the previous two numbers provided until the summer of 2003).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or at 703-305-3028 or at 703-308-6845 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: [ebc@uspto.gov](mailto:ebc@uspto.gov). Additional information is available on the Patent EBC Web site at: <http://www.uspto.gov/ebc/index.html>.

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Scott J. Sugarman  
Primary Examiner